

**REMARKS**

Claims 10, 12 to 16 and 19 are now pending in the present application.

It is respectfully requested that the present application be reconsidered since all of the presently pending claims are allowable.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement, PTO 1449 paper and cited references.

Claims 10, 12 to 16 and 19 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

While the rejections may not be agreed with, to facilitate matters, claims 10 and 15 have been rewritten to better clarify the claimed subject matter. Claims 10 and 15, as presented, make clear that the functional layer is created *after* the patterned porous layer is created and *before* a part of an underside of the functional layer is exposed. Claims 10 and 15, as presented, also make clear that a part of an underside of the functional layer is exposed by removing at least a part of the sacrificial layer. Withdrawal of the indefiniteness rejections is therefore respectfully requested.

Claims 10, 12 and 13 were rejected under 35 U.S.C. § 102(b) as anticipated by Japanese Patent Publication No. JP 06-324074 (“Sakata”).

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Final Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Final Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see Ex

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*parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'l. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

While the rejections may not be agreed with, to facilitate matters, claim 10 has been rewritten to better clarify the claimed subject matter.

Claim 10, as presented, includes the features of *creating a patterned porous region in a silicon substrate; creating a functional layer above the porous region, after the step of creating the porous region; and exposing at least a part of an underside of the functional layer, after the step of creating the functional layer, by removing at least a part of the sacrificial layer, the porous region being used at least partially as the sacrificial layer.*

The “Sakata” reference does not identically disclose (nor even suggest) the feature of *creating a functional layer above a porous region after creating the porous region*, as provided for in the context of the presently claimed subject matter. Even if the “Sakata” reference did refer to releasing a functional layer, the “Sakata” reference does not identically disclose (nor even suggest) the feature of *exposing at least part of an underside of a functional layer that was created after the creation of a porous region*, as provided for in the context of the presently claimed subject matter. In particular, the n+ field 12 referred to by the “Sakata” reference is *created before* the creation of the porous silicon region 16A referred to by the “Sakata” reference.

Accordingly, the “Sakata” reference does not anticipate claim 10, so that claim 10, as presented, is allowable, as are its dependent claims 12 and 13.

Claims 10, 12 and 14 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,542,558 (“Benz”).

While the rejections may not be agreed with, to facilitate matters, claim 10 has been rewritten to better clarify the claimed subject matter.

Claim 10, as presented, includes the features of *creating a patterned porous region in a silicon substrate; creating a functional layer above the porous region, after the step of creating the porous region; and exposing at least a part of an underside of the functional layer, after the step of creating the functional layer, by removing at least a part of the sacrificial layer, the porous region being used at least partially as the sacrificial layer.*

The “Benz” reference does not identically disclose (nor even suggest) the feature of *creating a functional layer above a porous region after creating the porous region*, as

provided for in the context of the presently claimed subject matter. Even if the “Benz” reference did refer to releasing a functional layer, the “Benz” reference does not identically disclose (nor even suggest) the feature of *exposing at least part of an underside of a functional layer that was created after the creation of a porous region*, as provided for in the context of the presently claimed subject matter. In particular, the silicon structures 6 referred to by the “Benz” reference are *created before* the possible conversion into porous silicon of the silicon layer 3 referred to by the “Benz” reference.

Accordingly, the “Benz” reference does not anticipate claim 10, so that claim 10, as presented, is allowable, as are its dependent claims 12 and 14.

Claims 13, 15, 16 and 19 were rejected under 35 U.S.C. § 103(a) as unpatentable over the “Benz” reference.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. See *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claims 13 and 19 depend from claim 10, as presented, and they are therefore allowable for essentially the same reasons as claim 10, since any knowledge of one with ordinary skill in the art does not overcome — and is not asserted to overcome — the critical

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shortcomings of the “Benz” references with respect to claim 10, as presented. Withdrawal of the obviousness rejections of claims 13 and 19 is therefore respectfully requested.

Claim 15, as presented, recites similar features as claim 10, as presented, and is therefore allowable for essentially the same reasons as claim 10, since any knowledge of one with ordinary skill in the art does not overcome — and is not asserted to overcome — the critical shortcomings of the “Benz” references with respect to claim 10. Withdrawal of the obviousness rejections of claim 15 and its dependent claim 16 is therefore respectfully requested.

Claim 14 was rejected under 35 U.S.C. § 103(a) as unpatentable over the “Sakata” reference in view of the “Benz” reference.

Claim 14 depends from claim 10, as presented, and is therefore allowable for essentially the same reasons as claim 10, since the “Benz” reference does not overcome — and is not asserted to overcome — the critical shortcomings of the “Sakata” references with respect to claim 10. Withdrawal of the obviousness rejection of claim 14 is therefore respectfully requested.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

Accordingly, claims 10, 12 to 16 and 19 are allowable.

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**CONCLUSION**

In view of the foregoing, all of pending claims 10, 12 to 16 and 19 are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested, as is allowance of the application.

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